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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,850	01/26/2004	Joerg Mueller	CM2587CQ	9786

27752 7590 06/09/2006

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EXAMINER
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BOGART, MICHAEL G

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/764,850	<b>Applicant(s)</b> MUELLER ET AL.	
	<b>Examiner</b> Michael G. Bogart	<b>Art Unit</b> 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>09 March 2006</u>   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Priority*

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Europe on 26 July 2001. It is noted, however, that applicant has not filed a certified copy of the EP 01117670.8 application as required by 35 U.S.C. § 119(b).

### *Claim Objections*

Claims 6 and 9 are objected to because of the following informalities:

Claim 6 recites the limitation "the slit openings" in line 1. There is insufficient antecedent basis for this limitation in the claim.

In claim 9, between "in" and "region", insert --a--.

Appropriate correction is required.

### *Claim Rejections – 35 USC § 102*

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13 and 14 are rejected under 35 U.S.C. § 102(b) as being anticipated by Endres *et al.* (EP 0 433 951 A2).

Regarding claim 13, Endres *et al.* teach a wearable absorbent article (10), preferably diaper or pull-on pants, having a backsheet (30) and a topsheet (26, 58) comprising a first waist region (46), a second waist region (44), and a crotch region (24) interposed there between, a longitudinal axis, and an opening (38), which provides a passageway to a primary void space

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(56) for receiving bodily exudates therein, positioned between the topsheet (26, 58) and the backsheet (30); whereby the opening (38) is positioned in at least the crotch region (24) along the longitudinal axis; whereby the topsheet (26, 58) is elasticated (58, 66)(see fig. 8, *infra*).

The reference is silent as to the steps for producing the article.

Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). MPEP § 2113.

There are no claimed steps which necessarily lead to a finished article which is materially different from that of the cited reference.

### ***Claim Rejections – 35 USC § 102/103***

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

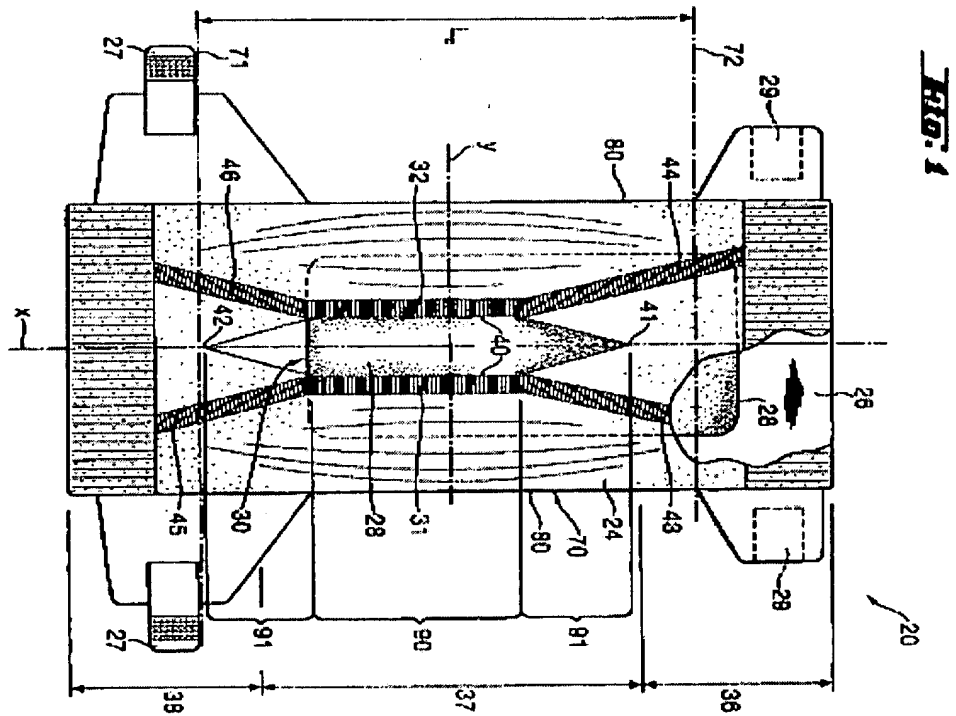
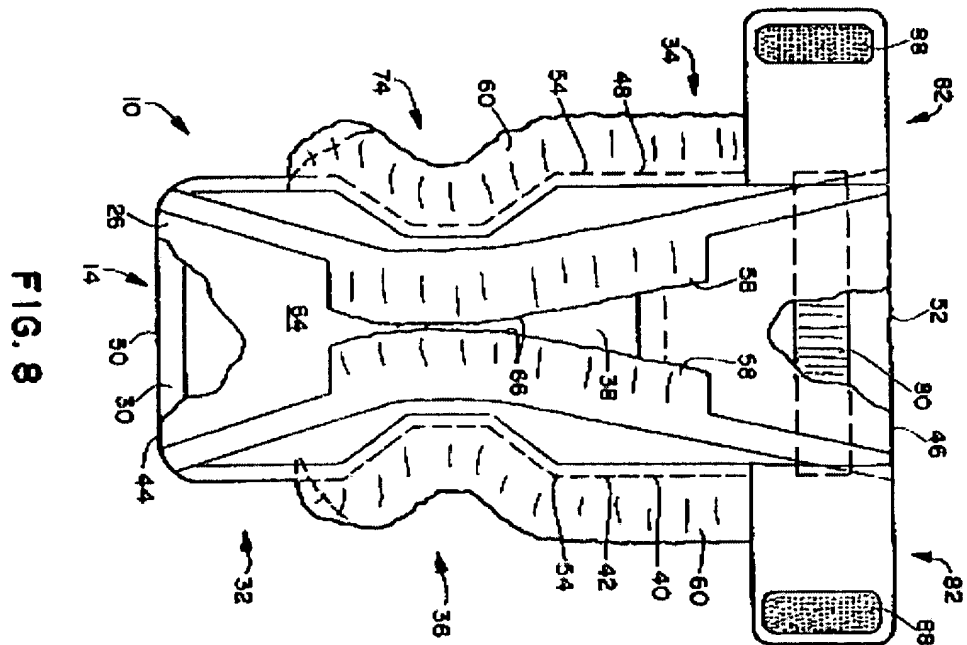
evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 1-7, 10 and 11 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Endres *et al.*

Regarding claims 1-4, Endres *et al.* teach an absorbent article (10) having a backsheet (30) and a topsheet (26, 58, 60) comprising a first waist region (46), a second waist region (44), and a crotch region (24) interposed there between, a longitudinal axis, and an opening (38), which provides a passageway to a primary void space (56) for receiving bodily exudates therein, positioned between the topsheet (26, 58, 60) and the backsheet (30); whereby the opening (38) is positioned in at least the crotch region (24) along the longitudinal axis; whereby the topsheet (26, 58, 60) is elasticated (58, 66)(col. 5, lines 1-51)(see fig. 8, *infra*).

Endres *et al.* are silent as to the specific stretch characteristics of the absorbent article.

Given the construction of the topsheet (26) and elastic elements (66) of the reference, and how they are applied in the same concave curvilinear manner as the elasticated topsheet of the instant invention, it inherently meets the stretch performance of the claimed invention (e.g., both the reference and instant invention use topsheets made of polypropylene; both impart elasticity to topsheet via elastic bands/ribbons)(see reference at col. 10, line 29-col. 11, line 56)(see Endres *et al.* fig. 8, *infra*; see fig. 1 of the instant invention, *infra*).



Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. §§ 102 and 103, expressed as a 102/103 rejection. “There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. § 103 and for anticipation under 35 U.S.C. § 102.” *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). This same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic. Therefore, a 35 U.S.C. § 102/103 rejection is appropriate for these types of claims as well as for composition claims.

“[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer.” *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, supra.

There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003).

“[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency’ under 35 U.S.C. § 102, on prima facie obviousness’ under 35

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U.S.C. § 103, jointly or alternatively, the burden of proof is the same...[footnote omitted].” The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, supra). MPEP § 2112.

Regarding claim 6, Endres *et al.* teach a slit opening (38) comprising longitudinally opposing side edges (66), each having one or more elasticated regions (58, 68) disposed along each of the side edges (66), preferably the length of the slit opening (38) being less than the length of the topsheet (26) and the elastic regions (58) being longer than the side edges (66), extending longitudinally from said side edges (66).

Regarding claim 7, Endres *et al.* teach a first waistband (46), adjacent to the first waist region (46) of the topsheet (26), to which one end of each of the elasticated regions (68) are connected, and a second waistband, adjacent to the second waist region (44) of the topsheet (26), to which the other end portion of each elasticated regions (68) are connected.

Regarding claim 9, Endres *et al.* teach an elasticated regions (58) in relaxed position are positioned under an angle with the adjacent area of the topsheet (26), such that the elasticated regions (58) bend away from the void space (56)(see figure 5, below).



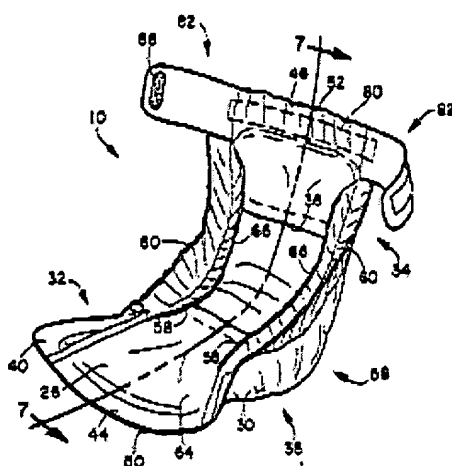


FIG. 5

Regarding claim 10, Endres *et al.* teach elasticated regions (58) that have each a first and second end edge and a first and second center point located therein between, the elastic regions (58, 68) each being curved such that the shortest distance between the first end edge of one elastic region and the first end edge of the other elastic region and also the shortest distance between the second end edge of one elastic region and the second end edge of the other elastic region, are both larger than the shortest distance between the first and second center point of the elasticated regions (see figure 8, *supra*).

Regarding claim 11, Endres *et al.* teach a diaper (see figure 8).

Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Endres *et al.*

Endres *et al.* do not teach the specific dimensions of the elastic band.

In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform

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differently than the prior art device, the claimed device was not patentably distinct from the prior art device. MPEP § 2144.04.

Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Endres *et al.* as applied to claims 1-11 above, and further in view of Roe (US 5,607,760 A).

Endres *et al.* do not teach a body lotion.

Roe teaches a diaper having a topsheet with a body lotion for skin comfort.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the lotion of Roe to the diaper of Endres *et al.* in order to provide a more comfortable topsheet.

### ***Response to Arguments***

Applicant's arguments filed 07 March 2006 have been fully considered but they are not persuasive.

Regarding claims 1-14, applicants assert that Endres *et al.* do not teach an elasticated topsheet. This argument is not persuasive because the reference teaches that both containment flap (58, 66) and side flaps (60, 70) can be integral portions of the topsheet (26)(col. 5, lines 1-51). Furthermore, the reference teaches that topsheet (26) can be made from an elastomeric film (col. 11, lines 1-10).

Applicants further assert that the threshold of inherency has not been met. The rejections of claims 1-12 have been clarified to include specifically where the reference teaches the same materials construction as the instant invention. The basis of the rejection has not been changed. Having the same materials and pattern of elastic attachment, Endres *et al.* inherently share the

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same elastic performance characteristics as the instant invention. Applicants have offered no proof that the apparatus of Endres *et al.* does not share the same elastic characteristics as the instant invention.

Regarding claims 13 and 14, applicants assert that the Endres *et al.* article is different from one made by the step “of applying elastic material over the total length of the active part of the elastic first, along the longitudinal axis of the sheet, to form a laminate having the elastic profile of claim 1.” This argument is not persuasive because as shown in the rejection of claim 1, the referenced article has the elastic profile that is the same as the instant invention. Furthermore, the referenced article can be made by applying elastic according to this step, and would result in an identical end product.

Applicants assert that the step of cutting a slit results in a different final product that that taught by the reference. This argument is not persuasive because whether edges (68) are separated by cutting or they were separate pieces of material to begin with, the end product is the same.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

In the event the examiner is not available, the Examiner's supervisor, Tatyana Zalukaeva may be reached at phone number (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Bogart  
1 June 2006

TATYANA ZALUKAEVA  
SUPERVISORY PRIMARY EXAMINER  
